



3-28-05

3618

PATENT  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Donald Barnett Harris

Appl. No. 09/827,173

Filed: April 6, 2001

For: HYBRID POWER SUPPLY MODULE

Commissioner for Patents  
P.O. Box 1450  
Alexandria, Virginia 22313-1450

Group Art Unit: 3618

Examiner: Fischmann, B.

Atty. Dkt. No.: 7002.120

EV567359292US

RESPONSE

In response to the restriction requirement contained in the Office Action dated May 14, 2004 and in response to the Office communication mailed February 11, 2005, Applicants hereby provisionally elect, for consideration on the merits, Species II of Category A (to which claims 1, 3, 12-15, and 18-20 correspond), and Species I of Category B (to which claims 1-3, 6-9, 12, and 14-20 correspond).

As the restriction maintained by the Examiner is believed erroneous (for the reasons enumerated below), this election is made with traverse and withdrawal of the subject restriction requirement is hereby respectfully solicited.

Regarding the traverse and the appropriateness of the subject restriction requirement, the MPEP outlines explicit guidelines in view of which restriction responses can be properly issued and maintained. In this regard, in order to satisfy the first prong of the test enumerated by the MPEP guidelines, separate claims must claim separate inventions which are both "independent" AND "distinct". If the inventions are not both, then a restriction requirement is not proper. See MPEP §806.05. Then, if and when the first prong has been satisfied, in the second prong of the test, the Examiner MUST show, by appropriate explanation, one of the following:

(A) Separate classification of the "inventions" of the claims: i.e. that there is a distinctive subject claimed which has attained recognition in the art as a separate subject for inventive effort, and also for a separate field of search;

(B) Separate status in the art when the inventions are classifiable together: Specifically, even though they are classified together, each subject can be shown to have formed a separate subject for inventive effort when an explanation indicates a recognition of separate inventive effort by inventors; or